REMARKS

Claims

Claims 54–56, 60–63, 68–70, 73, 74, 77–81 and 82–83 are currently under examination with claims 1–53, 55, 57, 58, 64–67, 71, 72, 75 and 76 previously cancelled without prejudice or disclaimer.

Allowable subject matter

Applicants submit that insofar as the subject matter of claim 82 was not rejected under any section nor objected to in the present Office Action, claim 82 and claim 83, which is dependent therefrom, should have been listed as "allowable" under item 5 of the Deposition of Claims section of the Office Action Summary. Favorable action is earnestly solicited.

Claim amendments

Amended claim 54 recites the elements of claim 60, which is hereby cancelled without prejudice or disclaimer. Claim 63 is cast as an independent claim and recites the element of claim 54. Claim 70 has been amended to use claim language according to conventional US practice. The dependency of claims 55, 56, 61, 62 and 67 has been changed.

Applicants have amended the product claims, i.e., 68–70, to recite further aspects of the genes of the present invention. Support for the amendment can be found, at least, in the disclosure contained in the Examples section of the specification.

It is respectfully submitted that the claim amendments do not add new matter. Entry thereof is earnestly solicited.

Rejection under 35 U.S.C. §112, ¶1 (Written Description)

(a) Claims directed to a process

At the outset it is submitted that the rejection is moot in view of the amendments. Claim 82 was not rejected under this section, and claims 55, 56, 61, 62 and 67 have been made dependent thereon. Moreover, Applicants have amended independent claim 54 to recite the aspects of the allowed claim. The two claims also differ in scope, at least with respect to the identity of the genes. Withdrawal of the rejection, at least with respect to the Applicants' method claims, is respectfully requested.

(b) Claims directed to a product

Applicants have amended product claims 68–70 and the claims dependent thereon to recite

yeast genes. This is not to imply that the original claim scope was problematic under US law. Applicants' claims satisfy the statutory requirements under §112, 1st paragraph as established under *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1566 (Fed. Cir. 1997)), wherein the Lilly Court held that "[a] description of a genus of cDNAs may be achieved by means of a recitation of a representative number of cDNAs, defined by nucleotide sequence, falling within the scope of the genus or of a recitation of structural features common to the members of the genus, which features constitute a substantial portion of the genus." In the instant application, the disclosure of representative species, for example, *S. cerevisiae* ADH1, which fall within the claimed genus of yeast ADH1, provides more than an adequate written description of the claimed molecules.

Applicants have further reviewed the PTO's new *Written Description Guidelines* and submit that the present claims conform to exemplary claim 2 of Example 15 beginning on Page 51 of the *Training Materials* (Rev. 1, March 25, 2008). While applicants may not agree with the agency's interpretation of the elements necessary to meet the statutory requirements of 35 U.S.C. § 112, ¶1, nonetheless, the pending claims substantially conform to these.

In the aforementioned Example, it is taught that the exemplary specification discloses a working example in which a full-length cDNA was isolated from a mouse cDNA library. The complete cDNA sequence (SEQ ID NO: 1) and predicted amino acid sequence (SEQ ID NO: 2) are disclosed. The specification states that the cDNA encodes a novel protein that the specification refers to as the murine "Squeaker" protein. The specification discloses a method for isolating human and other mammalian Squeaker cDNA sequences. However, the specification does not disclose any working examples showing isolation of other Squeaker cDNAs, and does not disclose any cDNA sequences other than the mouse sequence.

The representative claims are as follows:

Claim 1. An isolated nucleic acid comprising a nucleic acid sequence encoding a mammalian Squeaker protein.

Claim 2. (Analogous to present claims 68–70) The isolated nucleic acid of claim 1 wherein said nucleic acid sequence encodes mouse Squeaker protein.

The guidelines state that although claim 1 lacks adequate written description (because only mouse squeaker protein was disclosed), claim 2 satisfies the requirements set forth under §112, ¶1.

Since the instant claims are directed to yeast genes of the ergesterol metabolic pathway and insofar as the sequences are disclosed and known, the subject matter of Applicants' claims is analogous to the exemplary claim 2 of the guidelines. The guidelines explicitly state that the subject matter of the claim (i.e., mouse squeaker protein) is adequately described. To sustain this rejection

would thus be inconsistent with the USPTO's own published guidelines. Withdrawal of the rejection is respectfully requested.

In view of the above-mentioned arguments and amendments, it is respectfully submitted that the claims in the application are in condition for allowance. However, if the Examiner has any questions or comments, he is cordially invited to telephone the undersigned at the number below.

The Commissioner is hereby authorized to charge any fees associated with this response to Deposit Account No. 13-3402.

Respectfully submitted,

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